

## **REMARKS**

### **I. Drawings**

#### **A. Drawing Objections Under 37 C.F.R. § 1.83(a)**

In the Office Action, the drawings were objected to under 37 C.F.R. § 1.83(a). In particular, it was asserted that the “right angle turn transport” of claim 1 and the “controller” of claim 3 must be shown.

By this Amendment, Fig. 2 has been amended to include reference numeral 37 and associated lead lines to identify the right angle turn transport. A corresponding amendment was made to the Specification at page 11 to associate reference number 37 with the right angle turn transport.

In addition, Fig. 2 has been amended to include the controller in three places, each with reference numeral 14 and a lead line. Corresponding amendments were made to the Specification at pages 9 and 12 to associate reference number 14 with the controller.

Support for the controller is provided at numerous locations in the as-filed Specification. For example, in a description of conventional devices at page 3, lines 5-6, the Specification provides, “[t]he **control system** for the inserter senses markings on the individual pages to determine what pages are to be collated together in the accumulator module.” (Emphasis added.) With reference to an embodiment of the invention, the Specification provides at page 8, lines 1-4, “the speed of the rotary cutter and right angle turn mechanism are **controlled** to adjust a quantity of sheets . . . during a deceleration of the system.” (Emphasis added.) Additional support is provided at page 12, lines 5-9, “the right angle turn transports are subjected to a **controlled**

deceleration,” and “the speeds of the rotary cutter 21 and right angle turn transport are **controlled**.” (Emphasis added.) Still further, the as-filed Specification provides support for the controller at page 13, lines 15-17: “In a typical embodiment, the next processing station downstream of the accumulator 40 will be a folder 50 configured to fold the collation . . . required by the **control system**.” (Emphasis added.) Finally, the as-filed Specification describes multiple operations of the systems according to the invention that are carried out by the controller. See at least page 9, lines 13-22; page 12, line 22 to page 13, line 2; page 14, lines 9-20; and page 16, lines 3-10. Accordingly, Applicants respectfully submit that no new matter has been added by these amendments.

B. Other Drawing Objections

In the Office Action, the drawings were objected to as failing to comply with 37 C.F.R. § 1.84(p)(5). In particular, it was asserted that the drawings do not include reference numeral 100. Further, it was asserted that reference numeral 22 lacks a lead line.

By this Amendment, Fig. 2 has been amended to include reference numeral 100 and an associated lead line to identify the web. Further, Fig. 2 has been amended to include a lead line from reference numeral 22 to the cutting blade.

Thus, Applicants respectfully submit that the drawings fully comply with 37 C.F.R. §§ 1.83 and 1.84 and that the objections should be withdrawn.

## **II. Specification**

In the Office Action, the disclosure was objected to based on an asserted informality relating to the status of the parent application.

By this Amendment, the Specification has been amended to update the status of the parent application, as suggested in the Office Action, to reflect amendments to the drawings, as discussed above, and to correct several typographical errors. Thus, Applicants respectfully submit that the objection to the Specification has been overcome and should be withdrawn.

## **III. Status of the Claims**

Claims 1-12 are pending. By this Amendment, claims 1, 3, and 8-10 have been amended.

## **IV. Claim Rejections Under 35 U.S.C. § 112**

In the Office Action, claims 1-7 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Regarding claim 1, it was asserted that the phrase “the right angle turn mechanism transporting individual sheets with a right angle turn transport having a first velocity” is unclear. In particular, it was asserted that “the right angle turn mechanism is a part of the right angle turn transport.”

By this Amendment, claim 1 has been amended to recite, in pertinent part, “the right angle turn mechanism comprising a portion of a right angle turn transport transporting individual sheets at a first velocity.” Applicants respectfully submit that this amendment obviates the rejection of claim 1.

Regarding claim 3, it was asserted that the phrase “controller coupled to one or more sensors” is unclear. In particular, it was asserted that “[i]t is uncertain what

structure the controller incorporates and what structure allows the controller and the sensors to be coupled.”

According to M.P.E.P. § 2173.02, the “essential inquiry” pertaining to the “definiteness” requirement of § 112, second paragraph, is “whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity.” Further, “[d]efiniteness . . . must be analyzed, not in a vacuum, but in light of: (A) The content of the particular application disclosure; (B) The teachings of the prior art; and (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.” Id.

As discussed above, support for the controller was provided in the as-filed application, including numerous descriptions of its operation in embodiments of the invention. In addition, by this Amendment Fig. 2 has been amended to include the controller 14 and to show its association with the respective sensors 12, 13, and 35. Further, corresponding amendments were made to the Specification to clarify the association of the controller with the sensors.

Applicants respectfully submit that controllers are well known in the art and, further, that the “structure the controller incorporates” and the structure that “allows the controller and the sensors to be coupled” would have been understood by one possessing the ordinary level of skill in the pertinent art. Accordingly, Applicants respectfully submit that claim 3 meets the definiteness requirement of § 112, when analyzed in light of the “content of the particular application disclosure,” the “teachings of the prior art,” and the “claim interpretation that would be given by one possessing the

ordinary level of skill in the pertinent art at the time the invention was made,” as required by the M.P.E.P.

Thus, Applicants respectfully submit that the claims satisfy the requirements of 35 U.S.C. § 112 and that the rejection should be withdrawn.

**V. Double Patenting Rejections**

**A. Statutory Double Patenting**

In the Office Action, claim 8 was provisionally rejected under 35 U.S.C. § 101 as allegedly claiming the same invention as that of claim 10 of commonly-assigned, copending Application No. 11/286,036 (“the ‘036 application”). As explained below, this rejection should be withdrawn.

According to M.P.E.P. § 804, a statutory double patenting rejection is appropriate where the claims (between two applications in the present case) are “substantively the same.” Further, “[t]he ‘same invention’ in this context, means an invention drawn to identical subject matter.” *Id.* (citing Miller v. Eagle Mfg. Co., 151 U.S. 186 (1894)). Because claim 8 of the instant application and claim 10 of the ‘036 application are not drawn to identical subject matter, Applicants respectfully submit that the rejection should be withdrawn.

Claim 10 of the ‘036 application is reproduced below:

10. (Original) A method for generating sheets from a continuous web for creating mail pieces, the method comprising:
  - feeding a web of printed material at a first velocity in a first direction;
  - splitting the web along the first direction into at least two portions;

cutting the portions of slit web transverse to the first direction while the web is transported at the first velocity to form side-by-side individual sheets;  
turning the side-by-side sheets at a right angle whereby the individual sheets are rearranged to be one on top of the other in a shingled arrangement; and  
pulling individual shingled sheets out from the shingled arrangement whereby sheets are thereafter transported serially and separated by predetermined gaps.

Claim 10 of the '036 application fails to teach "transporting the individual sheets at a first velocity and turning the side-by-side sheets at a right angle whereby the individual sheets are rearranged to be one on top of the other in a shingled arrangement, the first velocity being a function of the cutting rate multiplied by the document width," as recited in claim 8 of the instant application.

Because claim 8 of the instant application and claim 10 of the '036 application are not drawn to identical subject matter, as required by M.P.E.P. § 804, Applicants respectfully submit that the rejection should be withdrawn.

B. Obviousness-Type Double Patenting

In the Office Action, claims 1 and 2 were rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claim 5 of commonly-assigned U.S. Patent No. 7,021,184. In addition, claims 8-10 were provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 10 and 12-14 of the '036 application.

These rejections are rendered moot by terminal disclaimers filed herewith.

**VI. Claim Rejections Under 35 U.S.C. § 103**

In the Office Action, claims 1, 2, 4-9, 11, and 12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,443,447 to Ifkovits et al. in view of U.S. Patent No. 5,439,208 to Moser et al. As explained below, this rejection should be withdrawn.

According to M.P.E.P. § 2143.03 (citing In re Royka, 180 USPQ 580 (CCPA 1974)), “[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” Because Ifkovits and Moser fail to teach or suggest Applicants’ claimed combination recited in independent claims 1 and 8, Applicants respectfully submit that a prima facie case of obviousness has not been established and that the rejection should be withdrawn.

Ifkovits teaches a “continuous web cutter for providing cut sheets and a right angle transport device for stacking the cut sheets.” Ifkovits at col. 1, lines 7-9.

Ifkovits fails to teach or suggest Applicants’ combination recited in claim 1, including at least a “right angle turn transport transporting individual sheets at a first velocity, the first velocity being a function of the cutting rate multiplied by the width of the individual sheets.”

Further, Ifkovits fails to teach or suggest Applicants’ claimed combination recited in claim 8, including at least “transporting the individual sheets at a first velocity . . . the first velocity being a function of the cutting rate multiplied by the document width.”

Moser teaches a “turnover-sequencer staging apparatus” in which “seriatim-imbricated sheets are selectively de-imbricated” by several methods, including “speeding up of the leading sheet.” Moser at Abstract.

However, Moser fails to overcome the deficiencies of Ifkovits discussed above.

It was asserted in the Office Action at page 10 that Moser teaches that the “high speed separation transport has a velocity **capable of being** the function of the cutting rate multiplied by a sum of the length of the individual sheets and the gap.” (Emphasis added.) Applicants respectfully submit that such an unsupported assertion does not meet the requirements of a prima facie case of obviousness, namely, that “all the claim limitations must be taught or suggested by the prior art.”

Because the combined teachings of Ifkovits and Moser fail to teach or suggest Applicants’ claimed combination recited in independent claims 1 and 8, as required by M.P.E.P. § 2143, Applicants respectfully submit that a prima facie case of obviousness has not been established and that the rejection should be withdrawn.

Applicants respectfully submit that independent claims 1 and 8 are patentable over the references applied in the Office Action. Claims 2-7 and 9-12 depend directly or indirectly from claims 1 and 8 and therefore should be allowable for at least the same reasons the claims from which they depend are allowable.



**VII. Conclusion**

Applicants respectfully request that the Examiner reconsider this application, withdraw the claim rejections, and allow the pending claims in a timely manner.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 16-1885.

Respectfully submitted,

/Christopher H. Kirkman/  
Christopher H. Kirkman  
Reg. No. 46,223  
Attorney for Applicants  
Telephone: (203) 924-3852

PITNEY BOWES INC.  
Intellectual Property and  
Technology Law Department  
35 Waterview Drive  
P.O. Box 3000  
MSC 26-22  
Shelton, CT 06484-8000

**Attachments:** One Replacement Drawing Sheet, consisting of Figs. 2 and 2A, and two Terminal Disclaimers.